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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

MOSE LARSEN *et al.*

Appl. No. 09/297,040

§ 371 Date: July 21, 1999

For: **Diabetes-Mediating Proteins and
Therapeutic Uses Thereof**

Confirmation No. 9201

Art Unit: 1652

Examiner: Steadman, D.

Atty. Docket: 2012.0390004/JAG/TJS

Reply to Restriction Requirement

Commissioner for Patents
Washington, D.C. 20231

Sir:

In reply to the supplemental Restriction Requirement dated November 5, 2002, requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the invention of Group II, represented by claims 6-11, 19, 22, and 23. Also, in reply to the request for election of a single protein from either Table 1 or Table 2 for examination on the merits, Applicants elect NEPHGE 298, Galectin 3 (Galactose Specific Lectin-3), the last entry on page 4 of Table 1. The period for reply has been extended four (4) months by the filing of the requisite petition and payment of the appropriate fee.

This election is made with traverse.

The present application is governed by unity of invention rules. In interpreting those rules, the MPEP states that "[a] group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves *at least one* common or corresponding special technical feature." See Manual of Patent Examining Procedure ("MPEP"), Eighth ed., rev. Feb. 2003, at

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§ 1893.03(d). The MPEP further states that "[t]he method for determining unity of invention under Rule 13 shall be construed as permitting, in particular . . . in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for the use of the said product." MPEP at AI-36 to AI-37 (quoting Annex B Part 2 of the PCT Administrative Instructions, as amended July 1, 1992).

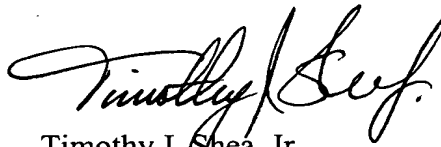
Applicants gratefully acknowledge the inclusion of claims 19, 22 and 23 in Group II along with claims 6-11. Applicants nevertheless respectfully submit that, at a minimum, claims 1-5, 12-13, and 14-15 should also be examined with Group II. The claims of Group II (claims 6-11, 19, 22 and 23) are directed to diabetes-mediating proteins and to methods of treating or preventing diabetes or a diabetes-related disorder by administering a diabetes-mediating protein capable of preventing or delaying the development of diabetes in a subject. Claims 1-5, 14 and 15 are directed to various *processes for identifying* diabetes-mediating proteins. Claims 12-13 are drawn to the use of said proteins for their characteristic properties in a comparative analysis, and thus are drawn to a *process for the use* of the proteins. Accordingly, the claims of Group II, as well as claims 1-5, 14-15, and 12-13 are all related as directed either to diabetes-mediating proteins, to processes specially adapted for the manufacture (*e.g.*, identification and isolation) of such proteins, or to uses for said proteins. The special technical feature common to all of these claims is the diabetes-mediating nature of the proteins. Applicants point out that this situation is similar to Example 1 set forth in Annex B Part 2 of the PCT Administrative Instructions, as amended July 1, 1992. *See* MPEP at AI-67.

In view of the above, Applicants respectfully request reconsideration and withdrawal of the Restriction Requirement, and a reformulation of the restriction groups. At a minimum, the Examiner should examine claims 1-5, 14-15 and 12-13 with the claims of Group II.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

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